

REMARKS

Claims 1 and 3-36 have been amended for the sake of clarity and contain no new matter. Claims 37 and 38 are new.

I. Claim Rejections – 35 U.S.C. 101

Claims 1 and 3-19 stand rejected under 35 U.S.C. 101 with regard to statutory subject matter. Claims 20-36 stand rejected under 35 U.S.C. 101 with regard to the four statutory categories of invention.

Claims 1 and 3-36 have been amended for the sake of clarity, contain no new matter, and are supported by the specification. Claims 1 and 3-36 as presented are directed to statutory subject matter, and as such, Applicants respectfully request that the 35 U.S.C. 101 rejections to these claims be withdrawn.

Claims 1 and 3-36 stand rejected under 35 U.S.C. 101 because the claimed invention allegedly cannot produce a concrete or repeatable result. Applicants note that, under the current case law, this is not the proper test for determining whether a claim satisfies 35 U.S.C. 101.

"[W]hile looking for 'a useful, concrete and tangible result' may in many instances provide useful indications of whether a claim is drawn to a fundamental principle or a practical application of such a principle, that inquiry is insufficient to determine whether a claim is patent-eligible under §101 ... [The Federal Circuit] conclude[s] that the 'useful, concrete and tangible result' inquiry is inadequate and reaffirm[s] that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply."

In re Bilski, 545 F.3d 943, 959-60 (Fed. Cir. 2008). Because claims 1 and 3-36 as presented satisfy the requirements of 35 U.S.C. 101, the rejections to these claims should be withdrawn.

II. Applicability of 35 U.S.C. 112, 6th Paragraph

This Final Office Action, like the Office Action before it, attempts to limit or restrict the interpretation of the means plus function language in the claims to the means disclosed “specifically in para. [0096] et seq. of the published application (US 20040204983A1).” (Office Action, p. 3). Applicants respectfully reiterate their opposition to any such attempted limitation or restriction. To the extent that any claims invoke 35 U.S.C. 112, sixth paragraph, Applicants insist that the entire specification and equivalents be considered when interpreting their means, as required by statute. (See 35 U.S.C. 112, sixth paragraph: “...such [means or step plus function] claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” (emphasis added)).

III. Advisory Claim Rejections – 35 U.S.C. 112

As stated in the Office Action, an “advisory rejection” is not a rejection. (Office Action, p.3 (“Applicant is put on notice that the following rejection would be applied to the instant claims if this were not a final rejection and would be applied to any future amended claims as appropriate.” (emphasis added))). As such, it is Applicants’ position that no response is required at this time. However, for the sake of expediting prosecution, Applicants note that the calculations referred to by the Office Action are not indefinite and are enabled in the specification by at least the formulas and processes described in paragraphs 0051 – 0086.

Applicants note that the Office Action’s statement that the “the applicant has failed to disclose any objective means or algorithm by which to perform said calculation” is inaccurate. (Office Action, p.4). Adequate disclosure is provided in the specification by at least the formulas and processes described in paragraphs 0051 – 0086. Applicants also note that the Office Action’s citation to Aristocrat Techs. Austl. Pty Ltd. v. Inter Game Tech., 521 F.3d 1328 (Fed. Cir. 2008) with regard to the means plus function language is improper.

First, with reference to claims 1 and 3-19 the citation is improper because Aristocrat exclusively considered means plus function claims. These claims do not recite means plus function language.

Second, with respect to the means plus function claims, Aristocrat is inapposite. The issue in Aristocrat was whether or not a specification provided adequate definiteness for means plus function claims. Specifically, the plaintiff in that case had merely disclosed a standard microprocessor and the phrase "appropriate programming" while attempting to claim a gaming machine with a game control to display images, pay a prize, and define pay lines for the game. No formulas or processes for the programming were disclosed by the plaintiff. The disclosure in Aristocrat is vastly different from the disclosure here (see at least paragraphs 0051 – 0086), where the specification offers explicit formulas and processes by which performance scores may be calculated. As such, claims 1 and 3-36 are not indefinite and are enabled.

IV. Claim Rejections – 35 U.S.C. 102

Claims 1, 3-9, 11, 14, 16-28, 30 and 34-36 stand rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al., US 20020042738A1 (hereinafter "Srinivasan").

A. Claims 1 and 3-19

Independent claim 1 recites a computer readable medium containing an executable method of determining, through the use of a processor, the performance of an advertisement. The computer readable medium includes a method of collecting a plurality of input data points and outcome data points and calculating performance scores based upon the input data points and the outcome data points. The outcome data points include one or more of data points about user opinions to identify a judgment of the user and data points about user experience to identify how enjoyable or annoying the advertisement was to the user.

Srinivasan does not teach the features presented in independent claim 1. For example, Srinivasan does not teach a computer readable medium containing an executable method which includes collecting data points about user opinions to identify a judgment of the user or data points about a user experience to identify how enjoyable or annoying an advertisement was to a user. Srinivasan also does not teach calculating performance scores based upon these data points.

In attempting to point out where these features are taught in the prior art, the Office Action cites to Srinivasan at paragraph 0029 and quotes the phrase "*statistics on the audience response*." (Office Action, p. 5). However, a full reading of Srinivasan makes clear that the statistics gathered on the audience response consist only of objective data such as click-through rates or buy-rates, and therefore does not teach a computer readable medium containing an executable method of determining the performance of an advertisement which includes gathering data on user opinions or user experience.

Srinivasan teaches a method where "the inventive system uses one or more objective functions for determining advertising effectiveness." (Srinivasan at 0085) (emphasis added). "[S]tatistics are kept by the system to determine what percentage of visitors are likely to exhibit interest ... [Such statistics] typically include, for example, the number of visitors who actually click-through each advertisement." (Srinivasan at 0084).

"Data is accumulated for each advertisement. This data typically include the fraction of visitors who click-through a particular ad, for example. Other data may include whether or not the customer purchased a particular product or a minimum 'basket' of products." (See Srinivasan at 0104). "The ad with the highest click-rate, or other measurement of the objective function, is then used as the default advertisement." (See Srinivasan at 0106) (emphasis added).

"The advertisements that are propagated from the experiment to the visitors may be conditioned on supplemental variables, such as length of time a visitor spends visiting the site, the number of items purchased, total value of

items purchased, prior purchasing history, and seasonality." (Srinivasan at 0113).

In the embodiments described, Srinivasan further emphasizes the use of objective functions only. "In one embodiment, the inventive system uses one or more objective functions for determining advertising effectiveness." (Srinivasan at 0086) (emphasis added). "The objective function may weigh multiple criterions [like both click-through rate and buy-rate]." (Srinivasan at 0087) (emphasis added). "In another embodiment, the objective function may be a combination of factors. For example, the objective function could be to meet a minimum click-through rate as well as a minimum buy-rate." (Srinivasan at 0088) (emphasis added).

Additionally, in the specific example offered by Srinivasan, the only variable considered in the experiment was the click-through rate, an objective data point. (See Srinivasan at 0114-0118).

While Srinivasan teaches considering objective factors such click-through rate or buy rates, it does not teach of collecting data points on user opinions to identify a judgment of the user or data points about a user experience to identify how enjoyable or annoying an advertisement is to a user.

Click-through rates and buy rates are not "opinions." Rather, an "opinion" is commonly referred to as "a belief or conclusion held with confidence but not substantiated by positive knowledge or proof." (emphasis added). See, e.g., The American Heritage Dictionary of the English Language, Fourth Edition, 2006 by Houghton Mifflin Company. (copy of relevant page attached). Click-through rates and buy rates, as well as the other objective factors suggested by Srinivasan, are all verifiable facts substantiated by proof; these are not data points about user opinions or user experience.

Because Srinivasan does not teach all of the features of independent claim 1, Applicants respectfully request the 102 rejection to this claim be withdrawn. Additionally, because dependent claims 3-9, 11, 14, and 16-19 contain all of the features of independent claim 1, Applicants respectfully request the 102 rejections to these claims also be withdrawn.

B. Claims 20-36

Independent claim 20 is directed to a computer readable medium containing a computer application capable of evaluating an advertisement. The computer readable medium includes data collecting means for collecting a plurality of data points about user opinions regarding the advertisement, and also includes data collecting means for collecting a plurality of data points about user experience regarding the experience of one or more users that have viewed the advertisement. The computer application also includes a calculating means for calculating performance scores from the plurality of data points.

As shown with respect to independent claim 1, Srinivasan does not teach a computer application capable of evaluating an advertisement which includes data collecting means for collecting a plurality of data points about user opinions regarding the advertisement and data collecting means for collecting a plurality of data points about user experience. Further, Srinivasan cannot and does not teach calculating performance scores from these data points.

Therefore, Applicants respectfully request the 102 rejection to independent claim 20 be withdrawn. Further, because dependent claims 21-28, 30, and 34-36 contain all of the features of independent claim 20, Applicants respectfully request the 102 rejections to these claims also be withdrawn.

C. Claims 9, 11, 14, 16, 28 and 30

Claim 9 contains all of the features of independent claim 1, and additionally includes displaying a survey concerning the advertisement to one or more users, collecting the results of the survey, and calculating at least one of the performance scores based on the survey results. Claim 28 contains all of the features of independent claim 20, and additionally includes means for displaying a survey concerning the advertisement to one or more users, means for collecting the results of the survey, and means for calculating one or more performance scores based on the survey results.

The Office Action, in presenting 102 rejections to these claims under Srinivasan, states that these features are found “inherently, to gather statistics on the audience response.” (Office Action, p. 5) (emphasis original). However, Srinivasan specifically denounces the use of surveys for gathering statistics on audience response. “[B]ecause of the speed at which Internet content is generated and modified, it is impractical to conduct human-mediated consumer preference surveys … it is not cost or time effective for webpage advertising.” (Srinivasan at 0022). Instead, as noted above, Srinivasan teaches only objective factors.

Because the additional features of claims 9 and 28 are not taught by Srinivasan, Applicants respectfully request that the 102 rejections be withdrawn. Additionally, because claims 11, 14, and 16 contain all of the features of claim 9, and claim 30 contains all of the features of claim 28, Applicants also respectfully request the 102 rejections to these claims be withdrawn.

V. Claim Rejections – 35 U.S.C. 103

Claims 10, 12, 13, 15, 29 and 31 – 33 stand rejected under 35 U.S.C. 103 as being unpatentable over Srinivasan. In making the 103 rejections, the Examiner takes official notice that pop-up windows were a common means of presenting surveys at the time of the instant invention, asking for comments in the surveys was also common, and key-word analysis would have been an obvious mechanical efficiency in analyzing these comments.

Preliminarily, Applicants respectfully assert that, with regard to the last officially noticed finding (“key-word analysis would have been an obvious mechanical efficiency in analyzing [text] comments”), the Office Action is improperly attempting to officially notice obviousness. Obviousness is a legal conclusion, and thus is not a factual determination which can be officially noticed. Therefore, with respect to this finding, Applicants respectfully request that the Office Action withdraw its official notice.

The Office Action’s official notice is based on the Examiner’s personal knowledge. Applicants again respectfully request that the Examiner provide an

affidavit or declaration setting forth specific factual statements and an explanation to support the findings. If the Office Action's official notice is not based on the Examiner's personal knowledge, Applicants respectfully request that the Examiner provide Applicants with one or more references or other documentary evidence to support the findings.

The Office Action states that "applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03)." (Office Action, pp. 5-6) (emphasis original). However, the language quoted from the Office Action is not found in the cited MPEP section. There is no indication in the MPEP that the burden is on Applicants to provide information or argument so that on its face it creates a reasonable doubt regarding the circumstances.

The Office Action also states that "[a]n effective traverse must be based on alleged evidence, not mere denial." (Office Action, p. 6). MPEP 2144.03 does not require this, but rather notes that "[t]o adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." The MPEP does not require Applicants to present evidence to effectively traverse the official notice.

MPEP 2144.03 offers only two examples of failures to adequately traverse an official notice. These two situations are when there exists an "absence of any demand by [applicant] for the examiner to produce authority for his statement" (Chevenard, 139 F.2d at 713); and when the applicant offers a general allegation of patentability "without any reference to the examiner's assertion of official notice." MPEP 2144.03. Neither situation exists here, as Applicants have both referenced the Office Action's official notice and insisted upon documentary support for the facts officially noticed.

In contrast to the two examples above, Applicants have satisfied the burden required to challenge the officially noticed facts by both pointing out the

supposed errors in the examiner's action and stating why the noticed fact is not considered to be common knowledge or well-known in the art.

First, in Applicants' previous response, reiterated here, Applicants specifically point out the errors in the examiner's action; namely the taking of official notice of the above-described findings.

Second, Applicants have previously stated, and reiterate here, that they do not believe that pop-up windows were a common means of presenting surveys at the time of the instant application, nor that asking for comments in the surveys was also common at the time of the instant application. Applicants further state that they do not believe that key-word analysis would have been an obvious mechanical efficiency in analyzing these comments at the time of the instant application. Additionally, Applicants further believe that these findings, even if found to be true, are not capable of instant and unquestionable demonstration as being well-known.

Applicants' assertions sufficiently satisfy the burden on the Applicants, which is merely to state why the noticed findings are not considered to be common knowledge or well-known.

Applicants note that "while 'official notice' may be relied on, these circumstances should be rare when application is under final rejection." (MPEP 2144.03). Further, such facts must be "capable of such instant and unquestionable demonstration as to defy dispute." (Id., citing In re Knapp Monarch Co., 296 F.2d 230 (CCPA 1961).). "If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence." (MPEP 2144.03(C)) (emphasis added).

As the MPEP requires, these findings, which by rule must be "capable of instant and unquestionable demonstration as being well-known," must now be supported by documentary evidence. Applicants respectfully insist that such documentary evidence illustrating these facts be provided.

However, even in the event the facts officially noticed are proven true, which Applicants do not presently admit or concede, claims 10, 12, 13, 15, 29 and 31 – 33 are allowable.

Claims 10, 12, 13, and 15 include all of the features of claim 1 and claim 9. As indicated previously, Srinivasan does not teach all of the features of claim 1. In addition, Srinivasan does not teach the additional features of claim 9. Further, none of the facts officially noticed teach those features not taught by Srinivasan. Because these features are not taught, irrespective of the consideration of facts officially noticed, claims 10, 12, 13 and 15 are allowable. Therefore, Applicants respectfully request that the rejections to these claims be withdrawn.

Claims 29 and 31 – 33 include all of the features of claim 20 and claim 28. Srinivasan does not teach all of the features of claim 20. Additionally, Srinivasan does not teach the additional features of claim 28. Furthermore, none of the facts officially noticed teach those features not taught by Srinivasan. For the reasons elaborated on above, claims 29 and 31 – 33 are allowable. Therefore, Applicants respectfully request that the rejections to these claims be withdrawn.

Applicants respectfully request entry of this Amendment and allowance of this application. The Examiner is invited to contact the undersigned attorney for the Applicants via telephone if such communication would expedite this application.

Respectfully submitted,



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